

NOV 06 2006

Application No.: 10/670,190Docket No.: 547-131**REMARKS**

To expedite prosecution, claims 2, 4-7, 10-12, 14 and 16 are canceled, with the subject matter of claim 2 now being incorporated in claim 1. Claim 1 has been amended to include the subject matter of former claim 2 and to obviate the rejection under 35 USC 112, paragraph 2. Claim 1 has also been amended so the former "providing" step has been removed and the subject matter thereof is now incorporated in the preamble of claim 1. As a result, infringement of claim 1 occurs by someone who performs the forming and removing steps without performing the "providing" step that was formerly included in claim 1. Since removal of the "providing" step of claim 1 does not affect the patentability thereof, claim 1, as amended, is patentable, based on the August 6, 2006 office action.

Claim 17 has been added to provide applicants with the protection to which they are deemed entitled. Claim 17 includes subject matter similar to that previously set forth in claim 1. As such, claim 17 does not include the substeps that have been added to claim 1, that is, the requirements to form a hole unit and fill the hole unit with a metal structure. The office action, on page 2, item 4, incorrectly alleges that the steps of forming a hole unit in the dielectric layer and filling the hole unit with a metal structure appear critical or essential to the practice of the invention.

The reliance on *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA

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1976) is incorrect because the Mayhew decision says a feature that is taught in the specification as being critical must be recited in the claims. There is no basis in the specification for the allegation that the steps of forming and filling are critical or essential to the practice of the invention. In fact, the second paragraph of the Summary of the Invention portion of the application as filed indicates an aspect of the invention has nothing to do with forming a hole unit and filling the hole unit with a metal structure. The Abstract also does not mention forming a hole unit and filling the hole unit with a metal structure. Section 2164.08(c) of the Manual of Patent Examining Procedure (MPEP) indicates that features which are merely preferred are not to be considered critical. This section of the MPEP indicates an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality. Since the abstract and a paragraph in applicants' application that indicates what an aspect of the invention is omit the allegedly critical features and the examiner has provided no rationale to support the criticality position, the former rejection of claim 1 based on 35 USC 112, paragraph 1 is wrong. Claim 17 should be allowed since no prior art was applied against former claim 1 and there is no basis in the record to support the rejection of claim 1 under 35 USC 112, paragraph 1.

In view of the foregoing amendments and remarks, allowance is in order.

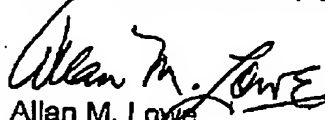
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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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